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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,879	09/08/2000	Toshihiko Oda	S0255.0004/P004	2562
24998	7590	08/16/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			PRIETO, BEATRIZ	
2101 L Street, NW			ART UNIT	
Washington, DC 20037			PAPER NUMBER	

2142

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,879

Applicant(s)

ODA, TOSHIHIKO

Examiner

Prieto B.

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6,9-12 and 15-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-6,9-12 and 15-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to Request for Continued Prosecution (RCE) and Amendment filed 6/22/05, claims 1-2, 7-8, 13-14 have been canceled, claims 3-6, 9-12 and 15-27 remain pending and hereby are set forth for examination.

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). Certified copy has been received of Application No. 11-255097, filed on 09/09/99 in Japan.

3. Claims 3-6, 9-12, and 15-27 are objected to because of the following noted minor informality: the claim or claims must commence on a separate sheet or electronic page (37 CFR 1.52(b)(3)), where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps.

4. Claim interpretation, the claimed terms functions, refers to features, capabilities or functions associated with (devices) printers. According applicant's disclosure a "profile of an ideal virtual device" seems to refer to all the capabilities of the devices collectively, i.e. "integrated" (see specs p. 11, lines 3 to page 17). The broadest reasonable interpretation will be given to the claim limitation in light of the specification (see MPEP § 2111).

Claim Rejection under 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The method claim 22 is directed to non-statutory subject matter. Specifically, claim 22 is not limited to tangible embodiments. According to applicant's specification, "Fig. 10 is a block diagram showing the hardware constitution of a device selecting apparatus according to an embodiment of this invention", however, this drawing illustrates "a display on a screen", according to p. 18, lines 9-10.

To overcome this type of rejection the claims need to be amended to include only the physical computer media or embodied on computer readable media medium, e.g. the computer-readable recording medium storing the program for performing the method, etc.

Claim Rejections - 35 USC § 103

6. Quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.

7. Claims 3-6, 9-12 and 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy et. al (US 6,496,859) (Roy hereafter) in view of Owa et. al. (US 6,348,971) (Owa hereafter).

Regarding claim 19, Roy teaches a system/method usable for selecting a device from a number of devices connected to a network, said apparatus comprising:

a detecting unit (10) which detects all the devices (35) connected to the network (45) (col 3/lines 27-37);

an extracting unit (10) which extracts information ("profiles") from the devices information (65) relating to identity of each said device (col 2/lines 31-38, 52-57, extract information: col 4/lines 3-12, data (65): col 3/lines 51-59 and col 5/lines 35-37);

an integrated profile creating unit (10) which creates a collection ("integrated profile") of information obtained by combining or adding the information ("profiles") of said devices (Roy: collection or adding information from and about all located devices: col 5/lines 42-col 6/line 9);

although prior art teach creating a table containing a listing of said devices used by the user for selecting a device from among said devices, prior art does not teach where the table contains a information about the functions available by the device e.g. for the use of each device,

Owa teaches a system/method related to the selection of the most appropriate device for use by a user (see abstract, col 1/lines 8-12, and col 2/lines 1-6) including,

a user print condition input section (14) from which a user selects information relating to functions or capabilities of said devices (col 4/lines 18-33, col 5/lines 1-25, profile relating functions or capabilities, col 3/lines 51-col 4/line 5, 53-59, profile, col 4/lines 53-59);

It would have been obvious to one ordinary skilled in the art at the time the invention was made given Roy's suggestion of discovering profiles comprising information relating to the functions or capabilities (categories) of multiple devices having multiple categories, to utilize Owa's teachings for enabling a user select an optimum device from among said devices having multiple categories such specific functions or capabilities, including selecting a device based on the user selected function or capability and the priority ranking of said devices, enabling the generation of a table which contains a

predetermined arrangement for the use of said devices and selecting a device from among the said devices based the user selected function/capability and the table containing the priority rankings, motivation would be to enhance Roy's system by preventing the user from devoting a lot of time and effort in checking a large number of devices for a desired specification and performance to select a device providing all the selected required functions, as suggest by Owa.

Regarding claim 3, a user interface created by said user interface creating unit which displays information relating to the functions comprising the integrated profile for a user's selection ("with respect to a user") on a display screen (Roy: Fig. 7) and enables the user to select necessary categories of functions from the categories of functions displayed on said display screen (Owa: user enters print conditions: col 4/lines 18-33, user specifies categories: col 5/lines 17-25, 30-31 setting desired print conditions on a GUI).

Regarding claim 4, a memory unit which stores the profiles extracted by said extracting unit (Roy: data structure to store device information: col 3/lines 5-59), wherein when said selecting unit has used ("consulted") the stored profiles and determined that there is no device comprising all the categories which have been selected via the user interface, said selecting unit selects said device from among said devices which comprises a part "subset" of the selected categories (i.e. given the stored profiles (device information), the categories (device function or capabilities) selected by the user and a predetermined priority, if no device comprises all the categories the device satisfying as much desirable conditions as possible is selected (Roy, col 5/lines 18-25).

Regarding claim 5, when a new category "reselects" has been selected via said user interface after said device has been selected, said selecting unit reselects said device by including the category which has been selected this time by priority in said part of the categories (i.e. selection of categories by priority enable the selection of device that satisfies selected category (or new category) when the device contains that is satisfies all required categories selected by the user according to a specified priority, e.g. priority B, wherein conditions that should preferable (most of or in part of the categories) (Owa: col 5/lines 1-25)

Regarding claim 6, wherein said devices are printers 35 (Roy: abstract, col 3/lines 27-37).

Regarding claims 9-12, these claims are substantially the same as claims 3-6, respectively, same rationale of rejection is applicable.

Regarding claim 13, this claim comprises the computer readable medium for storing instructions, which when executed by a computer, causes the computer to perform the functions discussed on apparatus claim 1, same rationale of rejection is applicable to the computer product claim.

Regarding claims 15-18, these claims comprises the apparatus or software implementation, i.e. computer readable medium for storing instructions, which when executed by a computer, causes the computer to perform the functions discussed on apparatus claims 3-6, respectively, same rationale of rejection is applicable to the computer product claims.

Regarding claim 20, a user interface creating unit which (i.e. a browser or web enable PC) which creates a user interface enabling functions (called “necessary functions”) to be selected from the functions on the integrated profile created by the integrated profile creating unit (Roy: col 1/lines 15-23 and Owa: enables the user to select necessary categories from the categories displayed on said display screen, col 4/lines 18-33, user specifies categories: col 5/lines 17-25, 30-31 setting desired print conditions on a GUI).

Regarding claim 21, creating a table related to a priority order of said devices in which the devices have a preference base on predetermined criteria, i.e. are “preferably used” (Roy: a device having the highest final score is selected “selecting unit” as an optimum device printer from among the printers using a criterion, col 6/lines 66-col 7/line 11).

Regarding claims 22-23, this claim is substantially the same as claims 19 and 3, respectively, as discussed above, same rationale of rejection is applicable.

Regarding claim 24, substantially the same as claim 21 as discussed above, same rationale of rejection is applicable.

Regarding claims 25-26, these claims comprise the computer readable medium storing the executable instructions associated with the method and apparatus discussed on claims 19-21, same rationale of rejection is applicable.

Response to Arguments

8. Regarding claim 1, 3-7, 9-13 and 15-18 rejected under 103 as being unpatentable over Roy in view of Owa, it is argued (p. of remarks) that the applied prior art does not teach an integrated profile comprising the all the functions of said devices.

In response to the above-mentioned arguments, applicant's interpretation of the applied prior art has been fully considered. However, claim reads that the profiles comprise information related to functions of said device and that the integrated profile comprises the integrations of the profiles of each said device, thereby the integrated profiles has all the functions comprised each profile of every device.

Roy teaches an integrated profile creating unit (10) which creates a collection "integrated profile" of information obtained by combining or adding the information "profiles" of said devices, thereby the integrated profiles has all the information comprised each profile of every device (Roy: collection or adding information from and about all located devices: col 5/lines 42-col 6/line 9), however that information does not include the functions of said devices. Owa teaches obtaining information about the devices on the network, the information specifically, including information relating to the functions of said devices (col 3/lines 51-col 4/line 13).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given Roy's suggestion of discovering profiles comprising collective information relating to the functions or capabilities (categories) of multiple devices on the network having multiple functions/capabilities, to utilize Owa's teachings for integrating profiles having all the functions comprised each profile of every device on the network. One would be motivated to enable a user to select an optimum device from among said devices having multiple categories such specific functions or capabilities, including selecting a device based on the user selected function, capability or performance and the priority ranking of said devices, enabling the generation of a table which contains a predetermined arrangement for the use of said devices and selecting a device from among the said devices based the user selected function/capability and the table containing the priority rankings, motivation would be to enhance Roy's system by preventing the user from devoting a lot of time and effort in checking a large number of devices for a desired specification and performance to select a device providing all the selected required functions, as suggest by Owa.

9. Applicant's arguments have been fully considered but not found persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

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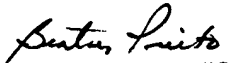
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BEATRIZ PRIETO
PRIMARY EXAMINER
August 13, 2005